

S/N 10/060,753

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Toshifumi Komatsu et al.	Examiner:	Amanda C. Walke
Serial No.:	10/060,753	Group Art Unit:	1795
Filed:	January 30, 2002	Docket No.:	970.0098US01
Title:	INK RECEPTIVE PHOTSENSITIVE LAMINATE		

Petition to Withdraw Holding of Abandonment Under 37 CFR 1.181(a)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

Applicant hereby petitions for withdrawal of the holding of abandonment under 37 CFR 1.181(a). The following items are being filed herewith:

1. Statement of Facts beginning on **page 2** of this paper.
2. Statement of Rules and Regulations beginning on **page 3** of this paper.
3. Argument beginning on **page 4** of this paper.
4. Statement of Diligence by Applicant's representative beginning on **page 5**.
5. A copy of the decision by the Board of Appeals and Interferences rendered December 18, 2009.
6. A copy of the Notice of Abandonment mailed on 03/16/2010.

Statement of Facts

On March 30, 2007, a Notice of Appeal was filed for Application Serial No. 10/060,753 challenging Examiner's rejections of Claims 1-3, 5-6, 9, 16, 17, 19, and 21-25. A decision was rendered by the Board of Patent Appeals and Interferences on December 18th, 2009, which affirmed Examiner's rejection with regard to Independent Claim 1 and reversed Examiner's rejection with regard to Independent Claim 23. Applicant was not made aware of any formal matters needing correction by the Applicant after this decision.

A Notice of Abandonment was mailed by Examiner on March 16, 2010 for the above-referenced application, citing as the reason, "The decision by the Board of Patent Appeals and Interference rendered on December 18 2009 and because the period for seeking court review of the decision has expired and there are no allowed claims."

Applicant has been in repeated telephone communication with Examiner Amanda Walke since issuance of the Notice of Abandonment in hopes of reaching a mutual understanding of the legal requirements in this situation. Since that time, Applicant and Examiner Walke have been unable to come to a resolution as to whether the Notice of Abandonment is proper. At this point Applicant believes review by the Petition Office is necessary to gain resolution, and now respectfully requests that this Petition to Withdraw the Notice of Abandonment be granted.

Applicant respectfully requests a withdrawal of this holding of abandonment under 37 CFR 1.181 because, in accordance with the MPEP 1214, Applicant-Appellant was not required to file a reply following the 12/18/2009 decision, and was entitled to a Notice of Allowance or an Office Action in response to the Board's decision from Examiner.

Statement of Relevant Rules & Regulations

(emphasis added)

37 C.F.R. §1.197

(a) Jurisdiction over an application or patent under ex parte reexamination proceeding passes to the examiner after a decision by the Board of Patent Appeals and Interferences upon transmittal of the file to the examiner, subject to appellant's right of appeal or other review, for such further action by appellant or by the examiner, as the condition of the application or patent under ex parte reexamination proceeding may require, *to carry into effect the decision of the Board of Patent Appeals and Interferences.*

(b) Termination of proceedings. (1) Proceedings on an application are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action except: (i) *Where claims stand allowed in an application;* or (ii) *Where the nature of the decision requires further action by the examiner.*

MPEP 1214.06

...Examiners must be very careful that case files that come back from the Board are not overlooked because *every case, except applications in which all claims stand rejected after the Board's decision, is up for action by the examiner in the event no court review has been sought...*

...When the time for seeking court review (plus 2 weeks to allow for information as to the filing of an appeal or civil action, if any, to reach the examiner) has passed without such review being sought, *the examiner must take up the application for consideration.*

...II. Claims Stand Allowed

The appellant is not required to file a reply. The examiner issues the application or *ex parte* reexamination certificate on the claims which stand allowed. For paper files, a red-ink line should be drawn through the refused claims and the notion "Board Decision" written in the margin in red ink.

If the Board affirms a rejection of claim 1, claim 2 was objected to prior to appeal as being allowable except for its dependency from claim 1 and independent claim 3 is allowed, the examiner should cancel claims 1 and 2 and issue the application or *ex parte* reexamination certificate with claim 3 only....

MPEP 12.120 Period For Seeking Court Review Has Lapsed

The period under 37 CFR 1.304 for seeking court review of the decision by the Board of Patent Appeals and Interferences rendered [1] has expired and no further action has been taken by appellant. The proceedings as to the rejected claims are considered terminated; see 37 CFR 1.197(b).

The application will be passed to issue on allowed claim [2] provided the following formal matters are promptly corrected: [3]. Prosecution is otherwise closed.

Argument

Applicant respectfully requests a withdrawal of this holding of abandonment under 37 CFR 1.181 because, in accordance with the MPEP 1214 and 37 CFR §1.197, Applicant-Appellant was not required to file a reply following the 12/18/2009 decision by the Board of Patent Appeals and Interference. The rejection of independent claim 23 was reversed by the Board and, as such, was up for action by the examiner. The Board's reversal of the rejection of Claim 23 rendered Claim 23 in condition for allowance or, at the very least, examination by the Examiner. Further, within the Board's opinion, the Board gave specific instructions to the examiner to cancel Claim 16, which would have required action on the Examiner's part before a response by the Applicant.

The Notice of Abandonment was improper, and should have been supplanted by action on the part of the Examiner to allow claim 23.

In view of the improper nature of the Notice of Abandonment, Applicant requests that it be reserved.

Statement of Diligence

Applicant has been in repeated telephone communication with Examiner Amanda Walke since issuance of the Notice of Abandonment 03/16/2010 in hopes of reaching a mutual understanding of the legal requirements in this situation. Since that time, they have been unable to come to an understanding. At this point Applicant has exhausted all avenues to achieve a conclusion with the Examiner, and now respectfully requests that this Petition to Withdraw the Notice of Abandonment be granted.

Respectfully submitted,

Date: October 20, 2010

/Daniel M. Pauly/
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